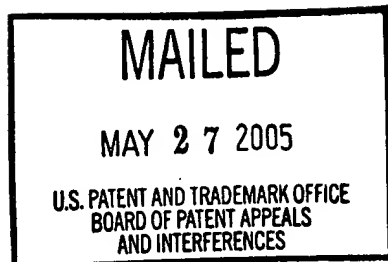


The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES



Ex parte JUDITH F. MILLER

Appeal No. 2005-0878
Application No. 09/911,620

ON BRIEF

Before WALTZ, KRATZ, and JEFFREY T. SMITH, Administrative Patent Judges.

WALTZ, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal from the primary examiner's final rejection of claims 1 through 5, 7, 8 and 10 through 22, which are all of the claims pending in this application. We have jurisdiction pursuant to 35 U.S.C. § 134.

According to appellant, the invention is directed to a new and improved breast prosthesis and bust cup system where highly comfortable wear is afforded the wearer by using a comfort pad which is removably attached to the rear surface of the prosthesis through rear hook material (Brief, page 3). Representative independent claims 1 and 19 are reproduced below:

1. A breast prosthesis and bust cup system adapted to be worn by a wearer comprising:

a breast prosthesis having a front surface and a rear surface, said rear surface being positionable adjacent to a wearer's body;

front hook material positioned on said front surface; rear hook material positioned on said rear surface;

a bust cup including loop material engagable with said hook material, wherein said breast prosthesis is receivable in said bust cup; and

a comfort pad attached to said rear surface through said rear hook material.

19. A breast prosthesis adapted for use by a wearer comprising:

a prosthesis having front surface and a rear surface, said rear surface being positionable adjacent to a wearer's body and having a first shape;

a comfort pad having a second shape generally congruent to said first shape; and hook and loop means for removably attaching said comfort pad to said rear surface.

The examiner relies upon the following references as evidence of unpatentability:

Brickman	3,161,200	Dec. 15, 1964
Eberl et al. (Eberl)	4,681,587	Jul. 21, 1987

Claims 19-20 stand rejected under 35 U.S.C. § 102(b) as anticipated by Eberl (Answer, page 3). Claims 1-5, 7-8, 10-17, and 21-22 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Brickman in view of Eberl (*id.*).¹ We affirm the rejection

¹We note that claim 18 is a pending claim on appeal (e.g., see the Brief, page 3, ¶ III; Answer, page 2, ¶(3)) but has not been included in any rejection (Answer, page 3, ¶(10)). Since
(continued...)

of claim 19 under section 102(b) over Eberl but reverse all other rejections on appeal for reasons which follow. Accordingly, the decision of the examiner is affirmed-in-part.

OPINION

A. The Rejection under § 102(b)

The examiner finds that Eberl teaches detachably coupling a "comfort" pad 3b to a breast prosthesis 1 utilizing hook-and-loop fasteners 7, where the pad has a "shape generally congruent" to the first shape of the rear surface (Answer, page 3, citing Figure 3 of Eberl).

Appellant argues that the examiner has improperly contended that Eberl teaches detachably coupling a comfort pad 3b to a breast prosthesis (Brief, page 5). Appellant argues that the

¹(...continued)
claim 18 depends from independent claim 10, we consider this claim with the rejection of claim 10 under section 103(a) as noted above. In view of our decision *infra*, there is no harm to appellant whether we consider claim 18 as allowed since the examiner inadvertently omitted the claim from any stated rejection, or if the claim is included in the section 103(a) rejection and reversed as discussed below. We also note that claims 16 and 18 lack antecedent basis in claim 10 for a "bust cup system," while claim 20 should include the term "and bust cup system" in the first line. Furthermore, we note that there is no antecedent basis for the "hook and loop means" recited in line 1 of claim 20. Appellant and the examiner should correct these formal matters upon return of this application to the jurisdiction of the examiner.

structure 3b of Eberl corresponds to appellant's prosthesis and clearly does not correspond to the claimed comfort pad (Brief, page 6).

Appellant's arguments are not persuasive. Eberl clearly teaches a mastoprosthesis made of a soft synthetic member (i.e., synthetic material member 7), where the back side of the mastoprosthesis is provided with a concavity which is filled with a pad member (i.e., pad member 3b; see col. 1, ll. 6-9, 15-18, 39-43, and 45-52). Eberl teaches that this pad member 3b is releasably connected to the synthetic material member by Velcro strip fasteners to facilitate removal for washing or replacement (col. 1, l. 65-col. 2, l. 15). Accordingly, Eberl teaches a prosthesis having a front and rear surface, with the rear surface capable of being positioned adjacent to a wearer's body, a pad having a shape "generally congruent" to the shape of the prosthesis, and hook and loop means for removably attaching the pad to the rear surface of the prosthesis (see Figure 3 of Eberl).

For the foregoing reasons and those stated in the Answer, we determine that the examiner has established that Eberl describes every limitation found in claim 19 within the meaning of section

102(b). Therefore we affirm the examiner's rejection of claim 19 under 35 U.S.C. § 102(b) over Eberl.

As noted on page 7 of the Brief and page 2, ¶(6), of the Answer, claim 20 does not depend on claim 19 but depends on claim 15, which ultimately depends on claim 1. Since the examiner has not established that every limitation of claim 20 has been described by Eberl within the meaning of section 102(b), we cannot sustain the rejection of claim 20 under 35 U.S.C. § 102(b) over Eberl.

B. The Rejection under § 103(a)

The examiner finds that Brickman discloses a breast prosthesis 40, 80 having hook material 42, 44 positioned on the front surface 46, where the hook material is configured to engage loop material 76, 77 positioned in a bust cup 30 for releasable attachment (Answer, page 3). The examiner finds that Brickman is silent in regard to any hook-and-loop fastener material on the rear surface of the breast prosthesis for attachment of a comfort pad (*id.*). Therefore the examiner applies Eberl for its teaching of detachably coupling a "comfort" pad 3b and 4 to a breast prosthesis 1 using hook-and-loop fasteners 7 (Answer, page 4). From these findings, the examiner concludes that it would have been obvious to one of ordinary skill in the art to have used the

pad attached by hook-and-loop fasteners to the rear surface of the breast prosthesis as taught by Eberl with the prosthesis of Brickman "to allow a substantially larger cavity" and thus reduce costs and the tendency of the prosthesis to collapse (*id.*).

Appellant correctly argues that nowhere in Brickman is there any teaching of a comfort pad in addition to a bust cup and breast prosthesis (Brief, page 7). Brickman teaches a swimsuit construction with a pair of "cup-shaped pads or inserts 40" (Figures 4, 5 and 6) or 80 (Figure 8) (col. 2, ll. 11-13 and 66-70). In addition, the examiner has not established any convincing reason, motivation or suggestion for the proposed combination of the swimsuit construction of Brickman with the breast prosthesis of Eberl. See *In re Dembiczak*, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999). The examiner has failed to establish why one of ordinary skill in the art of making breast prostheses would have been led to the swimsuit construction taught by Brickman. Furthermore, the examiner has not established why one of ordinary skill in the art would have added a "comfort" pad of Eberl, with its attendant fasteners, to the back of the pads 40, 80 of Brickman. The reasons given by the examiner (to allow a substantially larger cavity and reduce

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the tendency to collapse; Answer, page 4) have not been established as relevant to the swimsuit construction taught by Brickman.

For the foregoing reasons, we determine that the examiner has not established a *prima facie* case of obviousness in view of the reference evidence. Therefore we reverse the examiner's rejection of claims 1-5, 7-8, 10-18, 21 and 22 under 35 U.S.C. § 103(a) over Brickman in view of Eberl.

C. Summary

The rejection of claim 19 under 35 U.S.C. § 102(b) over Eberl is affirmed. The rejection of claim 20 under section 102(b) over Eberl is reversed. The rejection of claims 1-5, 7-8, 10-18, 21 and 22 under 35 U.S.C. § 103(a) over Brickman in view of Eberl is reversed. Therefore the decision of the examiner is affirmed-in-part.

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No time period for taking any subsequent action in connection with this appeal with this appeal may be extended under 37 CFR § 1.136(a)(1)(iv) (effective Sep. 13 2004; 69 Fed. Reg. 49960 (Aug. 12, 2004); 1286 Off. Gaz. Pat. Office 21 (Sep. 7, 2004)).

AFFIRMED-IN-PART

THOMAS A. WALTZ
Administrative Patent Judge


PETER F. KRATZ
Administrative Patent Judge

BOARD OF PATENT
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JEFFREY T. SMITH
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